



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,496	01/28/2000	Adam L. Cohen	06666/010005/2613	2322

7590 01/27/2003

ROBERTA P. SAXON
SKJERVEN MORRILL MacPHERSON LLP
25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110

EXAMINER

WONG, EDNA

ART UNIT PAPER NUMBER

1741

DATE MAILED: 01/27/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/493,496

Applicant(s)

COHEN, ADAM L.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 November 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other:

This is in response to the Amendment dated November 4, 2002. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 103

Claims **7-9** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **Jolly et al.** (US Patent No. 5,395,508) and **Arndt et al.** (US Patent No. 5,766,441).

The rejection of claims 7-9 under 35 U.S.C. 103(a) as being unpatentable over Jolly et al. and Arndt et al. has been withdrawn in view of Applicant's amendment.

Response to Amendment

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on November 20, 2001 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **7 and 9** are rejected under 35 U.S.C. 102(b) as being anticipated by **Trueba** (US Patent No. 5,560,837).

Trueba teaches a method of making a supported mask that may be used in modifying a substrate, comprising the steps of:

(a) obtaining a support **102, 106, 110** (Fig. 1D) that is not the substrate **118** (= workpiece);

(b) applying at least one layer of dielectric material **112** (= photoresist) [Fig. 1D] to said support; and

(c) exposing said layer to patterned light to substantially cause removal of said layer **112** from said support in exposed areas (= *photoresist* is masked and developed to a desired pattern) [col. 2, lines 1-28; and Fig. 1E].

The exposing causes ablation of the exposed areas of the layer (col. 2, lines 1-28; and Fig. 1E).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1753

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Trueba** (US Patent No. 5,560,837) as applied to claims 7 and 9 above.

Trueba is as applied above and incorporated herein.

Trueba does not teach wherein the pattern light is UV light.

However, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one skilled in the art would have been motivated to have modified the method of Trueba with wherein the pattern light is UV light because the light is a result-effective variable and one skilled in the art has the skill to determine the light that would carry out the desired reaction to occur, i.e., exposing and developing the photoresist, absent evidence to the contrary. MPEP § 2141.03 and § 2144.05(b).

Furthermore, it appears that the light would have depended upon the kind of photoresist that was applied.

Furthermore, exposing a photoresist to UV light is conventional in the art as taught by Trueba (col. 4, lines 41-48; and col. 5, lines 5-15). A positive photoresist such as AZ4230, which is available from Shipley Company, is exposed to UV light.

Furthermore, it has been held that the selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination. See

MPEP § 2144.06 and § 2144.07.

Citations

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hines (US Patent No. 6,019,784) is cited to teach a method comprising the steps of:

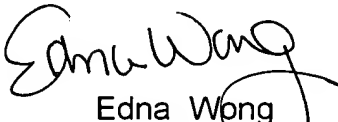
- (a) coating a mandrel (= support) with a resist;
- (b) exposing portions of said resist to a light pattern so as to form a stent pattern on said mandrel in said resist; and
- (c) plating metal onto said mandrel in said stent pattern so as to form a stent (= substrate) [col. 8, claim 1].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 873-9311 for After Final communications.

Art Unit: 1753

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.


Edna Wong
Primary Examiner
Art Unit 1753

EW
January 24, 2003